

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Adam John Walker
Serial No.: 10/599,694
Filed: January 19, 2007
For: LIQUIDS

Art Unit: 1796
Examiner: Douglas J. Mc Ginty
Conf. No.: 2909

TO THE COMMISSIONER FOR PATENTS,

FACTUAL SUPPORT: FAILURE TO REPLY WAS UNINTENTIONAL

Sir:

The patent Applicants of the above-identified application to Adam John Walker., Serial No. 10/599,694 (the "**Patent Application**"), recite the following facts showing the failure to reply was unintentional, and in general support of the Petition to Revive.

1. The research leading to the invention disclosed in the Patent Application was carried out by the inventor Dr. Adam Walker at the University of York, York, United Kingdom, which is the assignee of record (the "**Assignee**") on the Patent Application.
2. On 20th December 2004, the Assignee executed an agreement with Bioniqs, Ltd. of York, United Kingdom ("**Bioniqs**"), which authorized Bioniqs to control prosecution of the Patent Application, and further provided that all rights in the Patent Application including responsibility for prosecution would revert back to the Assignee if and when Bioniqs chose to relinquish control of prosecution of the Patent Application.
3. On or about June 30, 2009, Dr. Mark Mortimer, a Director of Bioniqs, contacted Ms. Sue Final, the IP Manager in the Research and Enterprise Office of the Assignee, to discuss returning all rights in the Patent Application, including control of prosecution, to the Assignee, though no decision was taken at that time.
4. When Dr. Mortimer met with Ms. Final, he failed to notify Ms. Final of the Office Action mailed on March 24, 2009 (the "Office Action").
5. During the period from March 24, 2009, the mailing date of the Office Action, through and including September 24, 2009, the expiration of the statutory period for filing a response, at no time did any representative of Bioniqs inform the Assignee of the outstanding Office Action nor of any urgency in responding to the USPTO for any reason concerning the Patent Application.
6. During the period from March 24, 2009 through and including September 24, 2009, legal counsel for the Assignee in the United Kingdom was unaware that

the Assignee was not kept informed by Bioniqs of the prosecution and status of the Patent Application.

7. Legal counsel for the Assignee in the United Kingdom, unaware that Bioniqs had asked Assignee to resume control of prosecution of the Patent Application, followed its prior instructions from the Assignee and continued to send notifications about the Office Action to representatives of Bioniqs, including Dr. Walker who had been employed by Bioniqs and no longer employed by the Assignee for several years.
8. Because the Assignee was unaware of any outstanding Office Action, the Assignee was never aware that a response was required and thus did not direct filing of a timely response.
9. A Notice of Abandonment regarding the Patent Application was issued on October 2, 2009 and mailed to the Assignee's legal counsel in the United States.
10. Assignee's U.S. counsel forwarded the Notice of Abandonment to Assignee's U.K. counsel, who duly forwarded same to representatives of Bioniqs following prior instructions from the Assignee.
11. No representative of Bioniqs ever informed the Assignee of the Notice of Abandonment.
12. The Assignee became aware of the outstanding Office Action and the Notice of Abandonment on the 2nd November 2009 and only recently over about the last 10-14 days became aware that it was possible to file a petition to revive the application. Through and including that time, the Patent Application was thought by the Assignee to remain in good standing.
13. Since becoming aware of the outstanding Office Action, the Assignee together with its legal counsel in both the United Kingdom and the United States have acted as quickly as possible to prepare a response to the outstanding Office Action and revive the Patent Application before the USPTO.

14. In view of the foregoing factual support, the patent Applicant respectfully requests revival of the Patent Application as the failure to reply was unintentional.

Respectfully submitted,

POLSINELLI SHUGHART PC

Dated: December 18, 2009

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